

REMARKS

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) as failing to show every feature of the invention specified in the claims. The examiner has rejected claim 22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In addition, the Examiner has rejected Claims 13-15 and 20-26 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,585,723 to Sumiya ("Sumiya"). The Examiner has also rejected Claims 16-19 under 35 U.S.C. § 103(a) as being unpatentable over Sumiya. Claim 13 stands currently amended to include all the language of Claim 20, and Claim 20 has been canceled. Claims 14-19 and 21-26 also stand currently amended. Claims 27-29 have been newly added. Claims 1-12 stand previously canceled. Claims 13-19 and 21-29 are currently pending. The following remarks are considered by applicant to overcome each of the Examiner's outstanding rejections to current Claims 13-19 and 21-29. An early Notice of Allowance is therefore requested.

I. SUMMARY OF RELEVANT LAW

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The determination of obviousness rests on whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. In determining obviousness, four factors should be weighed: (1) the scope and content of the prior art, (2) the differences between the art and the claims at issue, (3) the level of ordinary skill in the art, and (4) whatever objective evidence may be present. Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. The Examiner carries the burden under 35 U.S.C. § 103 to establish a prima facie case of obviousness and must show that the references relied on teach or suggest all of the limitations of the claims.

II. OBJECTION TO THE DRAWINGS UNDER 37 C.F.R. § 1.83(A)

On page 1 of the current Office Action, the Examiner objects to the drawings under 35 U.S.C. § 1.83(a) as failing to show every feature of the invention specified in the claims. These objections are respectfully traversed and believed overcome in view of the following discussion.

Fig. 1 has been amended to indicate the location of eyetracker unit 15, as described in paragraph [0025]. New Fig. 2 has been added to show the illumination source 1 arranged as a separate structural component part 14, to show a light guide 13, to show the monitoring unit 12, and to show multiple interfaces 10, as described in paragraphs [0019] – [0021]. New Figure 3 has been added to show the illuminating and irradiating unit is conceived as a modular unit 18, as described in paragraph [0028]. As such, Applicants respectfully assert that the figures now show every feature of the invention specified in the claims.

Accordingly, Applicants respectfully request Examiner withdraw the objections to the drawings under 35 U.S.C. § 1.83(a).

III. REJECTION OF CLAIM 22 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

On page 3 of the current Office Action, the Examiner rejects Claim 22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed and believed overcome in view of the following discussion.

In particular, the Examiner asserts that there is no description in the current Application of where and how the light guide connects to the illumination unit or to the illumination source, and how it generates specific illumination patterns. However, as explained below, a person skilled in the art would be able to use such light conductors without additional clarifications about the necessity of additional optical elements. Therefore, this information is not required to be included in the current Application.

For many technical instruments having for their use a light source which is preferably accommodated in the interior of the common housing, problems arise owing to the heat generated by the light source. In some cases, specific steps are taken within the common housing of the device to prevent overheating and conduct the generated heat to the outside in the most efficient manner possible. Another solution consists in providing the heat-generating light source with a separate housing so that the heat does not heat up the components located within the common housing. However, the problem with this solution is that the light generated by the light source must be conducted into the housing of the instrument.

According to the known prior art, light conductors are used for this purpose, for example. It is sufficiently well known from the prior art that the light conductor must have optical elements in the form of condenser optics for this purpose in order to conduct the transmitted light in and out. Therefore, a person skilled in the art would be able to use such light conductors without additional clarifications about the necessity of additional optical elements.

In ophthalmology and microscopy in particular, heating of this kind due to the light source is especially problematic because the predominantly optical elements located in the common housing are very sensitive to heat and the alignment can be negatively impacted by this.

Since the use of light conductors is sufficiently well known from the prior art, it is not necessary to include a detailed description of such in the current Application. Therefore, Applicants respectfully request the Examiner withdraw the rejection of Claim 22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

IV. REJECTION OF CLAIMS 13-15 AND 20-26 UNDER 35 U.S.C. § 102(B) BASED ON SUMIYA

On page 3 of the current Office Action, the Examiner rejects Claims 13-15 and 20-26 as being anticipated by Sumiya. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Claim 13 states, in part:

“means for generating specific illumination patterns and/or profiles; and

“wherein optical filters, diaphragms, and/or optoelectronic light modulators with a control unit are used as the means for generating specific illumination patterns and/or profiles.”

As such, Claim 13 requires that there is a means for generating specific illumination patterns and/or profiles. Examiner, however, appears to have completely overlooked this claim element in the current rejection of Claim 13. As such, the Examiner’s rejection of Claim 13 is fatally flawed, and is insufficient to establish a prima facie case of anticipation. The Examiner only obliquely asserts that Sumiya discloses such a means in examiner’s rejection of Claim 20, though Examiner fails to cite any examples of specific illumination patterns and/or profiles. This, however, misinterprets the teachings of Sumiya.

In particular, Sumiya is directed to a device for corneal surgery for ablating a portion of the cornea of a patient’s eye to correct refraction defects of the eye or to remove a lesion from an eye. Such ablation of the cornea of a patient’s eye is carried out, for example, with the aim of changing the refractive power for correcting ametropia such as myopia, hypermetropia, astigmatism, and the like or to remove an affected area of the cornea such as opacity.

For this purpose, Sumiya’s arrangement comprises an irradiation unit which directs a laser beam to an area on the cornea of a patient’s eye. But the laser beam is not focused on this area so as to generate specific illumination patterns and/or profiles.

Further, Sumiya’s arrangement comprises a cornea shape measuring unit for measuring the three-dimensional shape of the cornea which has an optical measurement light projection system for projecting measurement light onto the cornea. The measurement light reflected by the cornea is received and evaluated by an optical photodetector.

In order to calculate the three-dimensional shape of the cornea, the cornea is scanned in the X-Y directions. For this purpose, the projection spot of measurement light is

displaced on the cornea by a scan unit in X-Y directions. Accordingly, no specific illumination patterns and/or profiles are generated by the optical measurement light projection system either.

Therefore, Sumiya's solution does not contain any means for generating specific illumination patterns and/or profiles. The optical elements which the Examiner identifies as such means are not suited for generating illumination patterns and/or profiles.

As such, Applicant respectfully asserts that Examiner has failed to establish a prima facie case of anticipation of independent Claim 13, and corresponding Claims 14, 15, and 20-26 because they are each ultimately dependent from Claim 13. Therefore, Applicant respectfully requests that Examiner remove the rejection of Claims 13-15 and 20-26 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,585,723 to Sumiya.

V. REJECTION OF CLAIMS 16-19 UNDER 35 U.S.C. § 103(A) BASED ON SUMIYA

On page 6 of the current Office Action, the Examiner rejects Claims 16-19 as being unpatentable over Sumiya. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Claims 16-19 are dependent from independent Claim 13. As Claim 13 is allowable, so must be Claims 16-19.

In addition, Examiner admits that Sumiya fails to disclose the band lights and wavelengths specified in Claims 16-19. Rather, Examiner asserts that such band lights and wavelengths are obvious as discovering them only requires routine skill in the art. However, Examiner sites to nothing to support the assertion that such band lights and wavelengths only requires routine skill in the art other than Examiner's statement itself. Such a blind assertion without any factual support whatsoever is wholly insufficient to establish a prima facie case of obviousness. As such, Examiner assertion of obviousness of Claims 16-19 is fatally flawed.

Accordingly, Applicants respectfully assert that Examiner has failed to establish a prima facie case of obviousness of Claims 16-19. Therefore, Applicant respectfully requests that

Examiner remove the rejection of Claims 16-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,585,723 to Sumiya.

VI. NEW CLAIMS 27-29

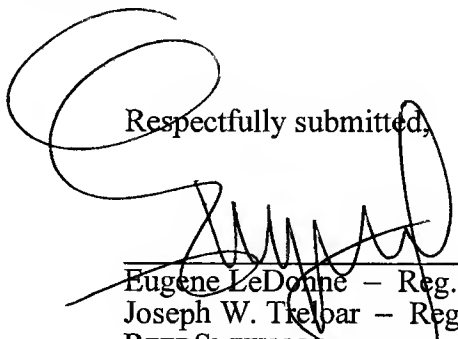
Claims 27-29 ultimately depend from independent Claim 13. As Claim 13 is allowable, so must be Claims 27-29.

In addition, Applicants respectfully assert that Sumiya fails to disclose or suggest the language of Claims 27-29.

Accordingly, Applicants respectfully assert that Claims 27-29 are allowable. Therefore, Applicants respectfully request Examiner allow Claims 27-29.

Based upon the above remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference with Applicants' attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,



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